

Chapter 500

Change of Ownership

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501 Assignment of Marks

501.01 Assignability of Marks in Applications and Registrations [R-2]

Extract from 15 U.S.C. §1060(a):

(1) A registered mark or a mark for which an application to register has been filed shall be assignable with the good will of the business in which the mark is used, or with that part of the good will of the business connected with the use of and symbolized by the mark.

Notwithstanding the preceding sentence, no application to register a mark under section 1(b) shall be assignable prior to the filing of an amendment under section 1(c) to bring the application into conformity with section 1(a) or the filing of the verified statement of use under section 1(d), except for an assignment to a successor to the business of the applicant, or portion thereof, to which the mark pertains, if that business is ongoing and existing.

(2) In any assignment authorized by this section, it shall not be necessary to include the good will of the business connected with the use of and symbolized by any other mark used in the business or by the name or style under which the business is conducted.

(3) Assignments shall be by instruments in writing duly executed...

*Extract from 37 C.F.R. §3.1. *** Assignment means a transfer by a party of all or part of its right, title and interest in a patent or patent application, or a transfer of its entire right, title*

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and interest in a registered mark or a mark for which an application to register has been filed.

501.01(a) Assignment of Intent-to-Use Applications [R-2]

Extract from 15 U.S.C. §1060(a)(1). A registered mark or a mark for which an application to register has been filed shall be assignable with the good will of the business in which the mark is used, or with that part of the good will of the business connected with the use of and symbolized by the mark. Notwithstanding the preceding sentence, no application to register a mark under section 1(b) shall be assignable prior to the filing of an amendment under section 1(c) to bring the application into conformity with section 1(a) or the filing of the verified statement of use under section 1(d), except for an assignment to a successor to the business of the applicant, or portion thereof, to which the mark pertains, if that business is ongoing and existing.

An applicant cannot assign an application that was filed under 15 U.S.C. §1051(b) before the applicant files an amendment to allege use under 15 U.S.C. §1051(c) of the Act or a statement of use under 15 U.S.C. §1051(d) of the Act, except to a successor to the applicant's business, or portion of the business to which the mark pertains, if that business is ongoing and existing. 15 U.S.C. §1060; 37 C.F.R. §3.16.

The primary purpose of this provision is to ensure that a mark may only be assigned along with some business or goodwill, and to prevent "trafficking" in marks.

As a general rule, the Office does not investigate or evaluate the validity of assignments. Therefore, the examining attorney should issue an inquiry concerning the compliance of an assignment with the cited provisions of §10 only if:

- (1) The application itself includes a statement indicating that the assignee is not a successor to the original applicant's business, or portion of the business to which the mark pertains, if that business is ongoing and existing; or
- (2) *All* of the following conditions are present:
 - (a) The assignment is executed before the filing of an acceptable amendment to allege use or statement of use;
 - (b) The applicant submits the assignment document for inclusion in the application record; *and*
 - (c) The assignment document fails to include the relevant language from §10 to the effect that the assignment includes the entire business of the applicant/assignor or the portion of the business to which the mark pertains.

If the examining attorney issues an inquiry, the applicant's statement that the assignment was in compliance with the cited provision of §10 is sufficient to resolve the issue. This statement may be entered through an examiner's amendment.

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The examining attorney should not require the submission of assignment documents to determine compliance.

The assignment of an intent-to-use application to someone who is not the successor to the applicant's business before filing an allegation of use renders the application and any resulting registration void. *Clorox Co. v. Chemical Bank*, 40 USPQ2d 1098 (TTAB 1996).

501.02 Assignments Must Be in Writing [R-2]

Extract from 15 U.S.C. §1060(a)(2). Assignments shall be by instruments in writing duly executed.

501.03 Effect of Failure to Record Assignment [R-2]

Extract from 15 U.S.C. §1060(a).

*(3) * * * Acknowledgment shall be prima facie evidence of the execution of an assignment, and when the prescribed information reporting the assignment is recorded in the United States Patent and Trademark Office, the record shall be prima facie evidence of execution.*

(4) An assignment shall be void against any subsequent purchaser for valuable consideration without notice, unless the prescribed information reporting the assignment is recorded in the United States Patent and Trademark Office within 3 months after the date of the assignment or prior to the subsequent purchase.

See TMEP §§503 *et seq.* regarding the recordation of assignments in the Assignment Services Division of the Office.

501.04 Foreign Assignee May Designate Domestic Representative [R-2]

15 U.S.C. §1060(b). An assignee not domiciled in the United States may designate by a document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving with that person or mailing to that person a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, or if the assignee does not designate by a document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark, such notices or process may be served upon the Director.

37 C.F.R. §3.61. If the assignee of a patent, patent application, trademark application or trademark registration is not domiciled in the United States, the assignee may designate a domestic representative in a document filed in the United States Patent and Trademark Office. The designation should state the name and address of a person residing within the United States on whom may be served process or notice of proceedings affecting the application, patent or registration or rights thereunder.

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An assignee not domiciled in the United States may designate, by a document filed in the Office, the name and address of a domestic representative. 15 U.S.C. §§1051(e), 1058(f), 1059(c) and 1060; 37 C.F.R. §3.61; TMEP §604. The Office encourages assignees who do not reside in the United States to designate domestic representatives.

When an assignee designates a domestic representative, the designation should be in a paper separate from the assignment document. One copy of the designation of domestic representative should be sent to the Assignment Services Division with the document to be recorded. In addition, the assignee should send a separate copy of the designation for each registration or application to which an assignment pertains to the Trademark Branch of the United States Patent and Trademark Office (Trademark Operation), so that a copy of the designation can be placed in each file that is identified in the assignment document. 37 C.F.R. §1.4(b).

501.05 Assignee Stands in Place of Applicant or Registrant

Extract from 15 U.S.C. §1127. The terms “applicant” and “registrant” embrace the legal representatives, predecessors, successors and assigns of such applicant or registrant.

*Extract from 37 C.F.R. §3.71. *** The assignee of a registered trademark or a trademark for which an application to register has been filed is entitled to conduct the prosecution of the trademark application or registration to the exclusion of the original applicant or previous assignee.*

An assignee, like an applicant, must be a natural or juristic person. *See* 15 U.S.C. §1127 and TMEP §803.

501.06 Partial Assignments

A trademark may be owned jointly by two or more persons (*see* TMEP §803.03(d)), and a joint owner may assign his or her interest in a mark. Also, a party who is the sole owner of a mark may transfer a portion of his or her interest (*e.g.*, 50%) in the mark to another party.

In addition, a trademark owner may assign a separate portion of a business, together with the good will and trademarks associated with that portion of the business, but retain rights in the mark for uses pertaining to another part of the business. *See VISA, U.S.A., Inc. v. Birmingham Trust National Bank*, 696 F.2d 1371, 216 USPQ 649 (Fed. Cir. 1982). A single trademark of a company can be validly assigned if the assignor transfers the good will associated with only some of the goods or services on which that mark appears. After a registration has been assigned with respect to only some of the goods or services, both owners must file the necessary affidavits of continued use or excusable nonuse under 15 U.S.C. §1058 and renewal applications under 15 U.S.C. §1059 to maintain the registration. If only one party files, only those goods or services in the registration for which that party owns the mark are continued or renewed. *See* TMEP §§1604 *et seq.* regarding affidavits of continued use or excusable nonuse, and TMEP §§1606 *et seq.* regarding renewal.

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A trademark owner may not use an assignment to impose geographic restrictions on a registration. This must be done by way of a concurrent use proceeding before the Trademark Trial and Appeal Board or pursuant to a final determination by a federal court. 15 U.S.C. §1052(d). See TMEP §§1207.04 *et seq.* and TBMP Chapter 1100 regarding concurrent use registration. However, the Assignment Services Division of the Office will record an assignment purporting to transfer rights in an unrestricted registration for less than the entire United States, because it is a transfer that may affect title to the registration. As noted in TMEP §503.01, the Assignment Services Division does not examine the substance of documents submitted for recording. The act of recording the document is not a determination of the validity or effect of the purported assignment and does not create a concurrent use registration.

502 Establishing Ownership of Applications or Registrations [R-2]

*Extract from 37 C.F.R. §3.73(a). * * * The original applicant is presumed to be the owner of a trademark application or registration, unless there is an assignment.*

Extract from 37 C.F.R. §3.73(b).

(1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:

(i) Documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment). The documents submitted to establish ownership may be required to be recorded pursuant to §3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office; or

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (e.g., reel and frame number).

(2) The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

(i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or

(ii) Being signed by a person having apparent authority to sign on behalf of the assignee, e.g., an officer of the assignee.

Recordation of an assignment of an application or registration in the Assignment Services Division of the Office is not mandatory. However, it is advisable for an applicant or registrant to record the assignment to ensure that it is valid under §10(a)(4) of the Act against subsequent purchasers for valuable consideration without notice.

When a party other than the owner of record attempts to take an action with respect to an application or registration (e.g., filing a response to an Office action, allegation of use under

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15 U.S.C. §1051(c) or §1051(d), request for an extension of time to file a statement of use under 15 U.S.C. §1051(d)(2), or affidavit of continued use or excusable nonuse under 15 U.S.C. §1058), the party must establish ownership of the application or registration. To establish ownership, the new owner must either: (1) record the assignment or other document of title with the Assignment Services Division, and notify the Trademark Operation that the document has been recorded, specifying the reel and frame number at which the document is recorded; or (2) submit other evidence of ownership, in the form of a document transferring ownership from one party to another or an explanation, in the form of an affidavit or declaration under 37 C.F.R. §2.20, that a valid transfer of legal title has occurred. 37 C.F.R. §3.73(b)(1).

Recording a document with the Assignment Services Division does not automatically change the record of ownership in the TRAM (Trademark Reporting and Monitoring) System, the database maintained by the Trademark Operation. To change the record of ownership in TRAM, the new owner must notify the Trademark Operation that ownership has changed. *See* 37 C.F.R. §3.85 and TMEP §§502.01 and 502.02 regarding issuance of a certificate of registration in the name of an assignee or new owner.

If a party records a document with the Assignment Services Division, the recordation will serve as constructive notice to subsequent purchasers under 15 U.S.C. §1060(a)(4) regardless of whether the party notifies the Trademark Operation of the recordation and regardless of whether the party requests issuance of a certificate of registration in the name of an assignee or new owner.

502.01 Pending Applications - Issuance of Registration Certificate in Name of Assignee or in Applicant's New Name

37 C.F.R. §3.85. Issue of registration to assignee. The certificate of registration may be issued to the assignee of the applicant, or in a new name of the applicant, provided that the party files a written request in the trademark application by the time the application is being prepared for issuance of the certificate of registration, and the appropriate document is recorded in the Office. If the assignment or name change document has not been recorded in the Office, then the written request must state that the document has been filed for recordation. The address of the assignee must be made of record in the application file.

While an assignee is not required to record the assignment in order to take an action with respect to an application or registration (*see* TMEP §502), the assignee must record the assignment to obtain a certificate of registration in the name of the assignee.

The Assignment Services Division is not part of the Trademark Operation. Recording a document with the Assignment Services Division does not change the record of ownership in TRAM, the database maintained by the Trademark Operation. The new owner must notify the Trademark Operation that the document has been recorded, and request that the Office issue a certificate of registration in the name of the new owner. 37 C.F.R. §3.85.

The name of a new owner or the new name of an applicant may not be entered into the TRAM System unless there is a title report in the application file indicating the recordation

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of an assignment or change of name and showing a clear chain of title. Office employees may obtain a title report through the Assignment Historical Database (*i.e.*, the automated records of the Assignment Services Division of the Office), available on the Office's internal computer network.

The Office will issue a certificate of registration to the assignee of the applicant, or in a new name of the applicant, only if the new owner: (1) files a written request that the registration be issued in the new name; *and* (2) records the appropriate document (*e.g.*, assignment document, change of name certificate) in the Assignment Services Division. 37 C.F.R. §3.85. The new owner bears the burden of recording *and* notifying appropriate Office personnel of assignments or changes of name to ensure that the registration issues in the name of a new owner. When a mark in a pending application has been assigned, the new owner should contact the examining attorney directly, preferably by e-mail or fax. *See* TMEP §502.01(a) regarding an examining attorney's handling of an application after the mark has been assigned.

A request that a registration issue in a new name should state that the appropriate document has been recorded or filed for recordation, and that the applicant wants the registration to issue in the name of the assignee or the new name of the applicant. The request should specify the assignee's address, and provide the reel and frame number of the recorded document, if available.

If possible, the new owner should file the request that the registration issue in a new name before the mark is approved for publication for opposition or registration on the Supplemental Register in an application based on 15 U.S.C. §1051(a) or §1126, or prior to acceptance of a statement of use in an application based on 15 U.S.C. §1051(b). The Office cannot ensure that a request filed after the mark has been approved for publication or registration to issue the certificate in a new name will be processed in time for the registration to issue in the name of the new owner.

If an applicant files, before the mark is approved for publication or registration, a written request that the Office issue the certificate in the name of the new owner, but the Office does not issue the registration in the name of the new owner, the Office will issue a certificate of correction. *See* 15 U.S.C. §1057(g), 37 C.F.R. §2.174, and TMEP §1609.09 regarding correction of an Office mistake, and TMEP §502.02 regarding issuance of a new certificate of registration to the new owner of a registered mark.

502.01(a) Examining Attorney's Action Regarding Assignment

If, prior to approval for publication for opposition or registration on the Supplemental Register, or prior to acceptance of a statement of use in an application under 15 U.S.C. §1051(b), the applicant advises the examining attorney or the examining attorney learns through some other source that an assignment has been recorded, the examining attorney should make sure that a title report showing a clear chain of title has been placed in the application file and that the change of ownership has been entered into TRAM before approving the mark for publication or registration. Office employees may obtain a title

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report through the Assignment Historical Database, available on the Office's internal computer network.

In general, the examining attorney should only issue an Office action questioning whether an assignment has occurred if an entity attempts to take action with respect to the application, and Office records show ownership in another party. The assignee must establish entitlement to take the action, either by recordation of an assignment, or submission of proof of the assignment. *See* 37 C.F.R. §3.73; TMEP §502.

During initial examination, the examining attorney should not suspend action or delay issuance of a final action to await recordation of a document. However, if the applicant submits a request indicating that the relevant document has been submitted for recordation and the application is in condition to be approved for publication for opposition or registration on the Supplemental Register, the examining attorney should withhold approval for publication or registration until the document has been recorded and the information regarding the assignment or the applicant's new name has been entered in the record and in TRAM. Likewise, during examination of the statement of use, the examining attorney should withhold final approval for registration until the relevant document has been recorded and the information regarding the assignment or the applicant's new name has been made of record and entered in TRAM. If the application is in condition to be approved for publication or registration, the examining attorney should suspend action pending the recordation of the document and the entry of the information into the application record and in TRAM.

See TMEP §1604.07(b) regarding the filing of an affidavit of continued use or excusable nonuse under 15 U.S.C. §1058 by an assignee.

502.02 Issuance of New Certificate to Assignee of Registrant

When ownership of a registered mark changes, recording a document with the Assignment Services Division does not change the owner of record in the TRAM database maintained by the Trademark Operation. The new owner must notify the Post Registration Section of the Office that the assignment document (or other document affecting title) has been recorded and provide the reel and frame number.

The name of a new owner or the new name of a registrant may not be entered into the TRAM System unless there is a title report in the registration file indicating the recordation of an assignment document or change of name and showing a clear chain of title. Office employees may obtain a title report through the Assignment Historical Database, available on the Office's internal computer network.

The Office will issue a new certificate of registration of the mark for the unexpired part of the registration period in the name of the new owner, if the new owner: (1) records the appropriate document (*e.g.*, assignment document, change of name certificate) in the Assignment Services Division; (2) files a written request that the registration be issued in the new name; *and* (3) pays the appropriate fee (37 C.F.R. §§2.6 and 3.41). The new owner

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must sign the request for a new certificate, and submit the original certificate of registration, if available. 15 U.S.C. §1057(d); 37 C.F.R. §§2.171 and 3.85.

Upon request and payment of the appropriate fee (*see* TMEP §111), the Certification Division of the Office will provide a certified copy that reflects ownership according to the records shown in the Assignment Historical Database. The certified copy will not show any transfer of ownership that has not been recorded in the Assignment Services Division.

See TMEP §1604.07(c) regarding the issuance of a notification of acceptance of an affidavit or declaration under 15 U.S.C. §1058 in the name of the new owner of a registration.

503 Recording in Assignment Services Division

503.01 Effect of Recording a Document

37 C.F.R. §3.54. Effect of recording. The recording of a document pursuant to §3.11 is not a determination by the Office of the validity of the document or the effect that document has on the title to an application, a patent, or a registration. When necessary, the Office will determine what effect a document has, including whether a party has the authority to take an action in a matter pending before the Office.

Recording a document with the Assignment Services Division does not change the ownership of record shown in TRAM. The new owner must notify the Trademark Operation that the document has been recorded. The Assignment Services Division is not part of the Trademark Operation. *See* TMEP §§502.01 and 502.02 regarding issuance of a certificate of registration in the name of a new owner.

The Assignment Services Division does not examine the substance of documents submitted for recording. The act of recording a document is a ministerial act, and not a determination of the document's validity or of its effect on title to an application or registration. The Office will determine the effect of a document only when an assignee attempts to take an action in connection with an application or registration (*e.g.*, when an assignee files a statement of use or an affidavit or declaration of use under 15 U.S.C. §1058). 37 C.F.R. §3.54.

Recording a document with the Assignment Services Division does *not* constitute a response to an Office action.

If an assignment is conditional on a given act or event at the time of its execution, the Office will view the submission of the assignment for recordation as an indication that the act or event has occurred. *See* 37 C.F.R. §3.56.

503.02 Documents That the Office Will Record [R-2]

37 C.F.R. §3.11 Documents which will be recorded.

(a) Assignments of applications, patents, and registrations, accompanied by completed cover sheets as specified in §§3.28 and 3.31, will be recorded in the Office. Other documents, accompanied by completed cover sheets as specified in §§3.28 and 3.31, affecting title to

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applications, patents, or registrations, will be recorded as provided in this part or at the discretion of the Director.

(b) Executive Order 9424 of February 18, 1944 (9 FR 1959, 3 CFR 1943-1948 Comp., p. 303) requires the several departments and other executive agencies of the Government, including Government-owned or Government-controlled corporations, to forward promptly to the Director for recording all licenses, assignments, or other interests of the Government in or under patents or patent applications. Assignments and other documents affecting title to patents or patent applications and documents not affecting title to patents or patent applications required by Executive Order 9424 to be filed will be recorded as provided in this part.

The Office records assignments of trademark applications and registrations, accompanied by completed cover sheets. The Office also records documents that affect title to a trademark application or registration, such as certificates issued by appropriate authorities showing a change of name of a business, or a merger of businesses. Although a mere change of name does not constitute a change of legal entity, it is properly a link in the chain of title. Documents of merger are also proper links in the chain of title.

Some instruments that relate to registered marks or to marks in pending applications may be recorded, even though they do not constitute a transfer or change of title to the mark or do not convey the entire title or interest in the business in which the mark is used. Typically, these instruments are license agreements, security agreements, and agreements between parties limiting future extension of use of a mark with regard to the goods or services or other circumstances of use. These instruments are recorded to give third parties notification of equitable interests or other matters relevant to the ownership of a mark.

The Office may also record a partial assignment of an interest in a mark. *See* TMEP §501.06.

503.03 Requirements for Recording

503.03(a) Formal Requirements for Documents

All documents submitted for recording must be legible. Only one side of each page should be used. The paper used should be flexible, strong, white, non-shiny, durable, and preferably no larger than 21.6 x 33.1 cm. (8½ x 14 inches) with a 2.5 cm. (one-inch) margin on all sides. 37 C.F.R. §3.25. Documents that do not meet the legibility and single-sided paper requirements will be returned. 37 C.F.R. §3.51. *See* TMEP §503.05.

All documents submitted for recording must be accompanied by a cover sheet that meets the requirements of 37 C.F.R. §3.31. *See* TMEP §503.03(e).

503.03(b) Supporting Documents

To record a document affecting title to a trademark application or registration, a legible cover sheet and one of the following must be submitted:

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- (1) The original document;
- (2) A copy of the document;
- (3) A copy of an extract from the document evidencing the effect on title; or
- (4) A statement signed by both the party conveying the interest *and* the party receiving the interest explaining how the conveyance affects title.

37 C.F.R. §3.25(a).

To record a name change, only a legible cover sheet is required.

503.03(c) English Language Requirement

The Office will not record a document that is not in the English language unless it is accompanied by a verified English translation that is signed by the translator. 37 C.F.R. §3.26.

If a non-English document is not accompanied by a translation, the Office will return it to the party who requested recordation. The document may be resubmitted with a translation. *See* TMEP §503.05.

503.03(d) Fee for Recording

All requests to record documents in the Assignment Services Division must be accompanied by the appropriate fee. A fee is required for *each* application and registration against which a document is recorded, as identified in the cover sheet. 37 C.F.R. §§2.6 and 3.41. The fee does not depend on the length of the document.

If not accompanied by the appropriate fee, a document submitted for recording is returned for resubmission of the document along with the required fee. *See* 37 C.F.R. §3.51; TMEP §503.05.

If the Assignment Services Division determines that materials submitted for recording do not meet the recording requirements, the fee is not refunded.

503.03(e) Cover Sheet [R-2]

Each document submitted for recording must be accompanied by at least one cover sheet that meets the requirements of 37 C.F.R. §3.31. Only one set of documents and cover sheets to be recorded should be filed. 37 C.F.R. §3.28.

Separate patent and trademark cover sheets should be submitted for documents that include interests in, or transactions involving, both patents and trademarks. If a cover sheet contains both patent and trademark information, any information contained therein about pending patent applications will become public record upon recordation. 37 C.F.R. §§3.28 and 3.31(b).

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The cover sheet must be legible. 37 C.F.R. §3.25(a). The Office has created a trademark cover sheet form that can be downloaded from the Office website at <http://www.uspto.gov/web/forms/pto1594.pdf>. Paper copies can be obtained from the Public Service Center at (703) 308-4357. Questions regarding cover sheets should be directed to the Assignment and Certification Services Division at (703) 308-9723. *See* notice at 1140 TMOG 65, 69 (July 28, 1992). Use of the Office's form is preferred, but not mandatory.

Under 37 C.F.R. §3.31, a trademark cover sheet must contain the following:

- (1) The name of the party conveying the interest;
- (2) The name and address of the party receiving the interest;
- (3) A description of the interest conveyed or transaction to be recorded (*e.g.*, assignment, license, change of name, merger, security agreement);
- (4) Each application serial number or registration number against which the document is to be recorded, if known. If the application serial number is not known, the party seeking to record the document must submit a copy of the application and/or a reproduction of the trademark and an estimate of the date that the Office received the application;
- (5) The name and address of the party to whom correspondence concerning the request to record the document should be mailed;
- (6) The date the document was executed; and
- (7) The signature of the party submitting the document.

The cover sheet should also indicate the entity of the conveying party and the relevant entity information for the receiving party (*e.g.*, the citizenship of individuals or names and citizenship of the general partners of a partnership); the number of applications and/or registrations identified in the cover sheet; the total fee; and an identification or description of the mark. 37 C.F.R. §§3.31(d) and (e). In addition, if the assignee has designated a domestic representative (TMEP §§501.04 and 604), the cover sheet should include an indication to this effect.

If not accompanied by a completed cover sheet, a document submitted for recording (and the incomplete cover sheet, if any) will be returned for proper completion of a cover sheet (*see* 37 C.F.R. §3.51; TMEP §503.05). 37 C.F.R. §3.28. *See* TMEP §§503.06(a) *et seq.* regarding correction of errors in cover sheets.

503.04 Address for Submitting Documents for Recording [R-2]

Requests to record documents in the Assignment Services Division can be filed through the Office's website, at <http://etas.uspto.gov>. Paper documents and cover sheets to be recorded in the Assignment Services Division should be sent to Mail Stop Assignment Recordation

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Services, Director of the United States Patent and Trademark Office, P. O. Box 1450, Alexandria VA 22313-1450. 37 C.F.R. §§1.1(a)(4)(i) and 3.27.

503.05 Recording Procedure and Recordation Date [R-1]

The recording of documents in the Assignment Services Division of the Office is governed by 37 C.F.R. Part 3.

The date of recordation is the date that the Office receives a cover sheet that meets the requirements of 37 C.F.R. §3.31 and a document affecting title that meets the requirements of 37 C.F.R. §3.25. 37 C.F.R. §3.51.

The party recording the assignment (or other document affecting title) should carefully review the assignment or other document and cover sheet for accuracy and completeness. The Assignment Services Division does not examine the substance of documents submitted for recording or compare the cover sheet with the original documents. Rather, the Office merely examines the materials submitted for form, to determine whether the requirements for recording have been met. *See* TMEP §§503.03 *et seq.*

If the materials submitted meet the requirements for recordation, the Assignment Services Division will record the document and cover sheet. Only the data specified on the cover sheet will be entered in the Assignment Historical Database. After recording the document and cover sheet, the Office will issue a notice of recordation of assignment and return the original document and cover sheet to the sender. The notice will reflect the data as recorded in the Assignment Historical Database. The information is not entered in the TRAM System unless the new owner notifies the Trademark Operation of the recordation of the document. *See* TMEP §§502.01 and 502.02. *See* TMEP §§503.06 *et seq.* regarding correction of errors in a cover sheet or recorded document.

Under 37 C.F.R. §3.51, the Office will return papers that do not meet the requirements for recording (*e.g.*, assignment documents submitted without a completed cover sheet, the appropriate fee, or an English translation, where applicable) to the sender for correction. The returned papers, stamped with the original date of receipt by the Office, will be accompanied by a letter indicating that, if the returned papers are corrected and resubmitted to the Office within a specified period of time, the Office will consider the original filing date of the papers as the recordation date of the document. The Office will not extend the time period specified in the letter. If the returned papers are corrected and resubmitted *after* the time specified in the letter, the recordation date is the date the Office receives corrected papers that meet the requirements for recording. The certificate of mailing procedure of 37 C.F.R. §1.8 and the “Express Mail” procedure of 37 C.F.R. §1.10 may be used for resubmitting the returned papers, to avoid lateness due to mail delay.

If papers submitted for recording are returned unrecorded by the Assignment Services Division, and the submitter believes that the papers were returned in error, he or she may file a petition under 37 C.F.R. §2.146. *See* TMEP §§1702 *et seq.* regarding petitions.

See TMEP §503.03(e) regarding the information that should be included on a cover sheet.

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503.06 Correction of Errors in Cover Sheet or Recorded Document

37 C.F.R. §3.34. Correction of cover sheet errors.

(a) An error in a cover sheet recorded pursuant to §3.11 will be corrected only if:

(1) the error is apparent when the cover sheet is compared with the recorded document to which it pertains and

(2) a corrected cover sheet is filed for recordation.

(b) The corrected cover sheet must be accompanied by the originally recorded document or a copy of the originally recorded document and by the recording fee as set forth in §3.41.

Once a document is recorded with the Assignment Services Division, the Assignment Services Division will not remove the papers from the record relating to that application or registration. See TMEP §503.06(e).

During the recording process, the Assignment Services Division will check to see that a trademark cover sheet is complete and record the data exactly as it appears on the cover sheet. The Assignment Services Division does not compare the cover sheet with the assignment document (or other document affecting title). Once the document is recorded, the Office will issue a notice of recordation.

The party recording the document should carefully review the notice of recordation.

Typographical errors made by the Office will be corrected promptly and without charge upon written request directed to the Assignment Services Division. For any other error, the party recording the document is responsible for filing the papers and paying the recordation fees necessary to correct the error, using the procedures set forth in TMEP §§503.06(a) through 503.06(d).

503.06(a) Typographical Errors in Cover Sheet

A party who wishes to correct a typographical error on a recorded cover sheet must submit the following to the Assignment Services Division: (1) the originally recorded assignment document (or other document affecting title), or a copy of the originally recorded document; (2) a corrected cover sheet; and (3) the required fee for each application or registration to be corrected (37 C.F.R. §§2.6 and 3.41). 37 C.F.R. §3.34. The party requesting correction should also submit a copy of the original cover sheet, to facilitate comparison of this cover sheet with the originally recorded document.

The party filing the corrected cover sheet should check the box titled “Other” in the area of the sheet requesting “Nature of Conveyance,” and indicate that the submission is to correct an error in a cover sheet previously recorded. The party should also identify the reel and frame numbers (if known), and the nature of the correction (e.g., “correction to the spelling of assignor’s name” or “correction of a serial number or registration number”).

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The Office will then compare the corrected cover sheet with the original cover sheet and the originally recorded assignment document (or other document affecting title) to determine whether the correction is typographical in nature. If the error is typographical in nature, the Assignment Services Division will record the corrected cover sheet and correct the Assignment Historical Database.

503.06(a)(i) Typographical Errors in Cover Sheet That Do Not Affect Title to Application or Registration

If the original cover sheet contains a typographical error that does not affect title to the application or registration against which the original assignment or name change is recorded, the Assignment Services Division will correct the Assignment Historical Database and permit the recording party to keep the original date of recordation.

503.06(a)(ii) Typographical Errors in Cover Sheet That Do Affect Title to Application or Registration

If the original cover sheet contains a typographical error that affects title to the application or registration against which the assignment or name change is recorded, the recording party will not be entitled to keep the original date of recordation. *See* TMEP §503.05. Rather, the Assignment Services Division will correct its automated records and change the date of recordation to the date the corrected cover sheet was received in the Office.

503.06(b) Typographical Errors in Recorded Assignment Document

If there is an error in the recorded assignment document (or other document affecting title) rather than in the cover sheet, the party responsible for an erroneous document (*e.g.*, the assignor) must either draft and record a new document or make corrections to the original document and re-record it. If an assignor is not available to correct an original document or execute a new one, the assignee may submit an affidavit in which the assignee identifies the error and requests correction. The affidavit must be accompanied by a copy of the originally recorded papers, a cover sheet (*see* TMEP §503.03(e)) and the required fee for each application or registration to be corrected (37 C.F.R. §§2.6 and 3.41). *See In re Abacab International Computers Ltd.*, 21 USPQ2d 1078 (Comm'r Pats. 1987).

503.06(c) Assignment or Change of Name Improperly Filed and Recorded By Another Person Against Owner's Application or Registration

When the owner of an application or registration discovers that due to a typographical error, another party has improperly recorded an assignment or name change against the owner's application or registration, the owner must correct the error by having a corrected cover sheet filed with the Assignment Services Division.

The owner should contact the party who recorded the papers with the erroneous information and have that party record corrective papers. However, if the party cannot be located or is

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unwilling to file corrective papers, then the true owner must record the necessary papers with the Assignment Services Division to correct the error.

Specifically, the owner should submit the following to the Assignment Services Division: (1) a completed cover sheet identifying the application or registration against which the assignment was improperly recorded; (2) an affidavit or declaration identifying itself as the correct owner, stating that the previously recorded document was submitted with erroneous information, and providing the reel and frame number of the previously recorded document; and (3) the required fee (37 C.F.R. §§2.6 and 3.41) for each application or registration to be corrected.

The affidavit or declaration should include a summary of the true chain of title to make it clear that the chain of title for the registration or application identified should not be considered altered by the incorrect assignment or name change, and a statement that the original registrant or last correct assignee has been and continues to be the owner of the application or registration at issue.

On the corrected cover sheet, the owner should check the box titled "Other" in the area of the cover sheet requesting the "Nature of Conveyance," and indicate that the submission is to correct an error made in a previously recorded document that erroneously affects the identified application(s) or registration(s). The party should also write the name of the correct owner in *both* the box requesting the name of the conveying party *and* the box requesting the name and address of the receiving party, to make it clear that ownership of the mark never changed and that any assignment or name change recorded against the application(s) or registration(s) was erroneous.

503.06(d) Owner Must Notify Trademark Operation of Correction

Recording a corrective document with the Assignment Services Division does not change the owner of record in the TRAM database maintained by the Trademark Operation. The owner must notify the Trademark Operation that the corrective document has been recorded. *See* TMEP §§502.01 and 502.02.

503.06(e) Recorded Documents Not Removed From Assignment Records

Once an assignment or other document is recorded against an application or registration, the Assignment Services Division will not remove the document from the records relating to that application or registration in the Assignment Historical Database, even if the assignment or other document is subsequently found to be invalid.

The goal of the Office is to maintain a complete history of claimed interests in a mark. Since the act of recording a document is not a determination of the document's validity, maintaining a complete record of claimed interests does not preclude an owner from using a mark, or from establishing its ownership of the mark in a proper forum, such as a federal court. *In re Ratny*, 24 USPQ2d 1713 (Comm'r Pats. 1992).

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503.06(f) Petitions to Correct or “Expunge” Assignment Records

To correct an error in a recorded document, the owner of an application or registration should record corrective papers with the Assignment Services Division, in accordance with the procedures outlined in TMEP §§503.06 through 503.06(d).

If the Assignment Services Division denies the request to correct the error, the owner may file a petition under 37 C.F.R. §2.146. *See* TMEP Chapter 1700 regarding petitions.

However, petitions to correct, modify or “expunge” assignment records are rarely granted. Such petitions are granted only if the petitioner can prove that: (1) the normal corrective procedures outlined in TMEP §§503.06 through 503.06(d) will not provide the petitioner with adequate relief, and (2) the integrity of the assignment records will not be affected by granting the petition.

Even if a petition to “expunge” a document is granted with respect to a particular application or registration, the images of the recorded document remain in the records of the Assignment Services Division. The Office will delete the links to the application or registration that was the subject of the petition, so that no information about the recorded document will appear when someone searches for that application or registration number in the Assignment Historical Database. However, the image of the document remains at the same reel and frame number, and it still will appear when someone views that reel and frame number.

503.07 “Indexing” Against Recorded Document Not Permitted [R-1]

The Office does not process requests for “indexing” or “cross-referencing” additional trademark registration numbers or application serial numbers against a document previously recorded in the Assignment Services Division.

Therefore, even when an assignment document (or other document affecting title) has already been recorded in the Assignment Services Division in connection with a trademark registration or application, a party who wants to record that document against additional applications or registrations must submit the following:

- (1) A copy of the originally recorded assignment document (or other document affecting title), a copy of an extract from the recorded document evidencing the effect on title, or a statement signed by both the party conveying the interest and the party receiving the interest explaining how the conveyance affects title (this may comprise a copy of the previously recorded papers on which the Assignment Services Division has stamped the reel and frame numbers at which they are recorded, or a copy of these papers);
- (2) A completed cover sheet (*see* TMEP §503.03(e)) that includes the number of each registration and/or application against which recordation of the assignment document (or other document affecting title) is requested; and
- (3) The appropriate recording fee (37 C.F.R. §§2.6 and 3.41).

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The Office will assign a new date of recordation for the additional applications or registrations, update the Assignment Historical Database, and microfilm the cover sheet and assignment document (or other document affecting title), which will become part of the official record. *See* notice at 1157 TMOG 12 (Dec. 7, 1993).

503.08 Accessibility of Assignment Records

The Assignment Services Division of the Office maintains separate records for patents and trademarks. 15 U.S.C. §1060; 37 C.F.R. §1.12(a)(1).

Assignments of trademark applications and registrations are open to public inspection upon recordation in the Assignment Services Division. *See* 37 C.F.R. §3.31(b) and TMEP §503.03(e) regarding the submission of separate cover sheets for documents that include interests in, or transactions involving, both patents and trademarks.

Before 1955, documents were recorded in bound volumes. The location of documents in these volumes is designated by “*liber and page*,” that is, by the number of the book (*liber*) and the number of the page in the book. Since 1955, documents have been recorded on microfilm, and are available for immediate inspection in the Trademark Assignment Search Room. The location of these documents is designated by “*reel and frame*,” that is, by the number of the reel on which they are microfilmed and the number of the frame on the reel.

All assignment records related to pre-1955 trademark records were transferred to the National Archives and Records Administration (NARA) in 1990. The United States Patent and Trademark Office (USPTO) still maintains records of all trademark assignments recorded on or after January 1, 1955.

All trademark assignment records from 1837 to December 31, 1954, are maintained and available for public inspection in the National Archives Research Room located at the Washington National Records Center Building, 4205 Suitland Road, Suitland, Maryland 20746. Assignments recorded before 1837 are maintained at the National Archives and Records Administration, 841 South Pickett Street, Alexandria, Virginia 22304.

Copies of assignment records recorded on or after January 1, 1955, may be ordered from the USPTO upon payment of the fee required by 37 C.F.R. §2.6. An order for a copy of an assignment record should identify the reel and frame at which it is recorded in the Assignment Services Division. If the correct reel and frame numbers are not identified (*e.g.*, the order identifies the document only by the name of the registrant and the number of the registration, or by the name of the applicant and the serial number of the application), the Office will charge an additional fee for the time spent searching for the document.

Requests for copies of pre-1955 trademark assignment records should be directed to NARA. Payment of the fees required by NARA should accompany all requests for copies. *See* 37 C.F.R. §1.12(a)(2).

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503.08(a) Abstracts of Title

Members of the public may obtain abstracts of title to particular registrations or applications from the Certification Division, Office of Public Records, upon payment of the fee required by 37 C.F.R. §2.6. *See* notices at 1140 TMOG 65, 66 (July 28, 1992) and 1165 TMOG 13 (Aug. 2, 1994).